UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,466	02/17/2004	Kyle Marvin	BEAS-01354US0	1399

23910   7590   05/09/2007

FLIESLER MEYER LLP
650 CALIFORNIA STREET
14TH FLOOR
SAN FRANCISCO, CA 94108

EXAMINER
STEELMAN, MARY J

ART UNIT	PAPER NUMBER
2191	

MAIL DATE	DELIVERY MODE
05/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/780,466	MARVIN ET AL.
	Examiner	**Art Unit**	
	Mary J. Steelman	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02/17/2004, 07/16/204</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>1/3/05, 2/7/05, 2/17/20, 2/28/05</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: IDS 3/11/05,3/16/05,7/5/06,11/28/06,11/29/06.

DETAILED ACTION

1.   Claims 1-35 are pending.

Information Disclosure Statement

2.   IDS received 01/03/2005, 02/07/2005, 02/07/2005, 02/28/2005, 03/11/2005, 03/16/2005, 07/05/2006, 11/28/2006, and 11/29/2006 has been considered. Due to the lengthy IDS submitted, Examiner requests that Applicant point to any known particularly pertinent references.

Specification

3.   The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 4, 10, 17, 24, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See MPEP 7.35.01 Trademark or Trade Name as a Limitation in the Claim

Claims 4, 10, 17, 24, and 31 contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or

product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph.

See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the

trademark or trade name cannot be used properly to identify any particular material or product.

A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Thus, a trademark or trade name does not identify or describe the goods associated with the

trademark or trade name. In the present case, the trademark/trade name is used to

identify/describe byte code programming language and, accordingly, the

identification/description is indefinite.

The trademark JAVA is improperly relied upon in the claims to incorporate the technical

features of a particular programming language environment. However, the trademark JAVA can

only properly define the source of the programming language environment, namely Sun

Microsystems, Inc. Accordingly, the identification/description is indefinite.

Sun Microsystems, Inc. is the sole producer and/or licenser of JAVA products. The

trademark JAVA identifies the source of the products and not the products themselves. In

contrast, for example, C++ is a name used in trade to identify a particular nonproprietary

programming language conforming to an accepted standard. Products and services incorporating

the name C++ are produced by numerous sources. Further, the technologies identified using the

trademark JAVA are continuously evolving. An example of this evolution can be found in "JSR

14: Add Generic Types To The Java™ Programming Language", which describes a proposed

amendment to the JAVA Language Specification submitted by Sun Microsystems, Inc., in 1999

and pending approval by the JAVA COMMUNITY PROCESS Program. In view of the

statements presented above, it is asserted that the trademark JAVA has no fixed definite

technical meaning. Accordingly, a rejection under 35 U.S.C. 112, second paragraph, based on

the use of the trademark JAVA as a limitation in a claim, is proper.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 14-27 are rejected under 35 U.S.C. 101 because claim limitations are directed

towards software per se, which is a non-statutory embodiment.

Claim 35 is rejected under 35 U.S.C. 101 because claim language recites "a computer

data signal embodied in a transmission medium..." Current guidelines exclude signals as

statutory, as they are not considered a physical article or object to constitute a manufacture

within the meaning of 101, which enables the software to act as a computer component and

realize its functionality.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1, 2, 4-7, 14, 15, 17-20, 28, 29 and 31-35 are rejected under 35 U.S.C. 102(e) as

being anticipated by US Patent 7,111,243 to Ballard et al.

Per claim 1, 14, 28, and 35:

A method for providing a reusable software control, comprising:

-incorporating the control into an Integrated Development Environment (IDE), wherein a graphical representation of the control can be interactively manipulated;

Ballard: FIG. 5 and related text at col. 17: 3-34, IDE 235 to add or modify user interface elements...text, graphics, images, fields, buttons...user interface element is selected...is a customizable property

-exposing services associated with the control and related to programmatically interacting with a portal;

Ballard: Col. 14: 60-67, col. 21: 53-55, server utilities, portal processor 365 that is used to handle the processing of data requests and instructions passed to and from user application interface 255

-wherein the control has a customizable interface.

Ballard: Col. 22: 41-43, A customized application user interface 255optionally includes a number of configurable user interface elements each further including a number of configurable properties As an example, (col. 18: 60 – col. 19: 3) privileged user viewing options determined at development specifies column data to be made available for a specified user.

Per claims 2, 15, and 29:

-the services can include: a first group of services related to portal tracking;

Ballard: Col. 14: 60-67 FIG. 7 & Col. 18: 17-36,

-a second group of services related to portal personalization.

Ballard: Col. 18: 60-67, optional display properties per specified user   col. 19: 16-17,

configuration is applied to only one user interface element on a specific user interface for a

specific user   col. 27: 4-11, customization of the interaction models used for communication

between internet application system 250 and the client displaying application user interface 255

Per claims 4, 17, and 31:

-the control includes annotated Java code.

Ballard: Col. 29: 28-44, HTML / Javascript...JAVA

Per claims 5, 18, and 32:

-the control can use other controls.

Col. 9: 37-39 & 46-58, A functional property of a user interface element (control) can include

logic, data processing and responsiveness to user input...The functionality of user interface

elements also includes the underlying processes associated with each element. ...displaying

error messages (in a text box control element), modifying the order of element focus...

Per claims 6, 19, and 33:

-specifying IDE characteristics of the control.

Col. 10: 1-27, The user interface elements developed in step 50...customizable properties. These

properties are either attributes of a predefined user interface element or are selected during the

design of the element...Step 50 optionally includes determination of a data record used to hold

value characterizing a customizable property of the user interface element and generation of

metadata including a reference to the data record (IDE characteristics).

Per claims 7, 20, and 34:

-the services related to interacting with a portal can include one or more of: portal

personalization, portal events and portal configuration.

Ballard: col. 27: 4-11, customization of the interaction models used for communication (portal

personalization)

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 3, 8-13, 16, 21-27, and 30 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent 7,111,243 to Ballard et al., in view of US Patent 7,062,718B2 to

Kodosky et al.

Per claims 3, 16, 23, and 30:

-the interactive manipulation of the control includes: graphically connecting the control to other

controls to establish flow-of-control at run-time.

Ballard disclosed (col. 27: 4-5) customization of the interaction models, but failed to explicitly

disclose 'graphically connecting the control to other controls to establish flow of control.

However, Kodosky disclosed a graphical programming environment, nodes (col. 2: 61-63) are

connected to show flow of program control.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the

invention, to modify Ballard, using the teachings of Kodosky, because one would be motivated

to (Kodosky, col. 2: 4-6) provide the capability for a user of developer to easily create, distribute

and / or deploy applications.

Per claims 8 and 21:

A method for providing a reusable software control, comprising:

-incorporating the control into an Integrated Development Environment (IDE), wherein a

graphical representation of the control can be interactively manipulated by graphically

connecting the control to other controls to establish flow-of-control at run-time;

-exposing services associated with the control and related to programmatically interacting with a

portal;

-wherein the control has a customizable interface.

Ballard disclosed customizable control elements and IDE. Ballard disclosed customizing the

portal communication interfaces, exposing services. See rejection of limitations addressed

above. Ballard disclosed (col. 27: 4-5) customization of the interaction models. Ballard failed to explicitly disclose connecting the control to other controls to establish flow of control at run time.

However, Kodosky disclosed such an invention. Kodosky disclosed a graphical programming environment, nodes (col. 2: 61-63) are connected to show flow of program control.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Ballard, using the teachings of Kodosky, because one would be motivated to (Kodosky, col. 2: 4-6) provide the capability for a user of developer to easily create, distribute and / or deploy applications.

Per claims 9 and 22:

Ballard: Col. 14: 60-67   FIG. 7 & Col. 18: 17-36

Per claims 10 and 24:

-the control includes annotated Java code.

Ballard: Col. 29: 28-44, HTML / Javascript...JAVA

Per claims 11 and 25:

-the control can use other controls.

Col. 9: 37-39 & 46-58, A functional property of a user interface element (control) can include

logic, data processing and responsiveness to user input...The functionality of user interface

elements also includes the underlying processes associated with each element. ...displaying

error messages (in a text box control element), modifying the order of element focus...

Per claims 12 and 26:

-specifying IDE characteristics of the control.

Col. 10: 1-27, The user interface elements developed in step 50...customizable properties. These

properties are either attributes of a predefined user interface element or are selected during the

design of the element...Step 50 optionally includes determination of a data record used to hold

value characterizing a customizable property of the user interface element and generation of

metadata including a reference to the data record (IDE characteristics).

Per claims 13 and 27:

-the services related to interacting with a portal can include one or more of: portal

personalization, portal events and portal configuration.

Ballard: col. 27: 4-11, customization of the interaction models used for communication (portal

personalization)

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Any inquiry concerning this communication or earlier communications from the

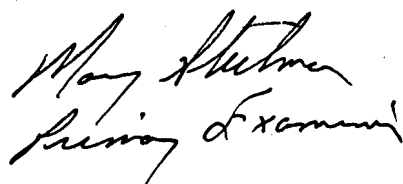examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The

examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM   If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this

application or proceeding is assigned: 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be

directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

04/12/2007